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Palmdale CA 93551

MAILED JUL 07 2006

In re Application of: KOFFROTH :
Appl. No.: 10/816,420 : DECISION ON PETITION
Filed: April 1, 2004 :
For: ICE BELT TO REDUCE BODY TEMPERATURE :

This is a decision on the petition filed October 11, 2005 by which petitioners request reconsideration of and withdrawal of the final rejection issued August 11, 2005, and admission of the new claim amendments included with the petition. The petition is considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is dismissed.

Review of the application and of the prosecution history shows that the application was filed on April 1, 2004. At filing, the application contained claims 1 and 2. On March 11, 2005 the examiner promulgated a first office action rejecting claims 1 and 2 based upon 35 USC 102 and 35 USC 103 in view of the Plewes reference. On April 22, 2005, petitioner responded to the first office action with the submission of arguments against the applied rejection. No claim amendments were submitted. On June 24, 2004, petitioner submitted a supplemental response which included claim amendments including the addition of new claims. On August 11, 2005 the examiner promulgated a final office action again action rejecting claims 1 and 2 based upon 35 USC 102 and 35 USC 103 in view of the Plewes reference. In the final office action the examiner noted the June 24, 2005 supplemental amendment did not meet the requirements of 37 CFR 1.111 and had not been entered. Petitioner now requests the finality of the office action be withdrawn and the entry of additional claims and claim amendments.

Petitioner fails to set forth any basis for granting petitioner's request. While the petition opines that petitioner's papers had been mishandled, such does not provide basis for the removal of a final rejection. Entry of supplemental amendments is guided by 37 CFR 1.111 which states (in pertinent part):

§ 1.111 Reply by applicant or patent owner to a non-final Office action.

(a)

(1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment. See §§1.135 and 1.136 for time for reply to avoid abandonment.

(2) Supplemental replies. (i) A reply that is supplemental to a reply that is in compliance with § 1.111(b) will not be entered as a matter of right except as provided in paragraph (a)(2)(ii) of this section. The Office may enter a supplemental reply if the supplemental reply is clearly limited to:

(A) Cancellation of a claim(s);

(B) Adoption of the examiner suggestion(s);

(C) Placement of the application in condition for allowance;

- (D) Reply to an Office requirement made after the first reply was filed;
 - (E) Correction of informalities (e.g., typographical errors); or
 - (F) Simplification of issues for appeal.
 - (ii) A supplemental reply will be entered if the supplemental reply is filed within the period during which action by the Office is suspended under § 1.103(a) or (c).
 - (b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.
- ...
- [46 FR 29182, May 29, 1981; para. (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a) and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a)(2) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (a)(2) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004; para. (a)(2)(i) revised, 70 FR 3880, Jan. 27, 2005, effective Dec. 8, 2004]

As correctly noted by the examiner, petitioner's supplemental amendment failed to meet the requirements of 37 CFR 1.111. Denial of entry by the examiner does not appear inappropriate.

Final rejection practice is described in MPEP 706.07. Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). In the present application, the examiner applied the same grounds of rejection and responded in full to all of petitioners presented arguments. Thus, issuance of the rejection as a final office action appears appropriate.

For at least the above reasons, the examiner was in compliance with proper examining practice as set forth in 37 CFR 1.111 and MPEP 706.07(a) in denying entry of the supplemental amendment and making the next Office action final. The examiner did not abuse his discretion, nor act in an arbitrary or capricious manner. Therefore, there appears to be no basis for granting the relief requested. Petitioner may file a request for reconsideration of this decision, without fee, if filed within two months of the date of this decision. See 37 CFR 1.181(f).

As a procedural note, petitioner should familiarize with 37 CFR 1.121 which describes the manner of making amendments in patent applications. It is noted that both the non-entered July 24, 2005 amendment as well as the amendment submitted with the instant petition failed to pass muster as to form of presentation. The claim amendments submitted October 11, 2005 will be treated as an after-final submission. Entry of claims after final is not a matter of right and is guided by 37 CFR 1.116. The application is being forwarded to the examiner of record for consideration of the amendment and issuance of an Advisory Action.

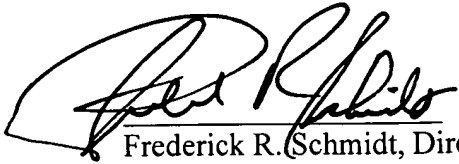
Further, noting 37 CFR 1.181 (f)

The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings.

Since the filing of a petition cannot be considered as a reply to the final rejection and no other action appears to have been taken by petitioner, the application appears to be abandoned.

Inquires regarding this petition decision may be directed to J. Harrison, TC 3700 Special Programs examiner at 571-272-4449.

PETITION DISMISSED

A handwritten signature in black ink, appearing to read "Fred R. Schmidt", written over a horizontal line.

Frederick R. Schmidt, Director
Technology Center 3700